IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	
GILBERT P. HYATT	Group Art Unit: 2621
Serial No. 08/464,034	Examiner: Brian Werner
Docket No. 751	
Filed: June 5, 1995	
For: IMPROVED IMAGE PROCESSING ARCHITECTURE	

RESPONSE AND AMENDMENT UNDER 37 CFR 1.111

Hon. Commissioner For Patents
P.O. Box 1450, Alexandria, VA 22313-1450

Sir:

In response to the Action dated May 3, 2004; the Applicant requests reconsideration for the reasons set forth hereinafter pursuant to 37 CFR 1.111 and for the reasons of record.

The Applicant requests that the objections and requirements be held in temporary abeyance until allowable subject matter is indicated. Authority is found in 37 CFR 1.111(b).

The rejections do not establish a prima facie case. Judge Plager, in his concurring opinion in Oetiker[1], stated:

> An applicant for a patent is entitled to the patent unless the application fails to meet the requirements established by law. It is the Commissioner's duty (acting through the examining officials) to determine that all requirements of the Patent Act are met. The burden is on the Commissioner to establish that the applicant is not entitled under the law to a patent. In re Warner, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). In rejecting an application, factual determinations by the PTO must be based on a preponderance of the evidence, and legal conclusions must be correct. In

1. In re Oetiker, 977 F.2d 1443, 1449, 24 USPQ2d 1443, 1447 (Fed. Cir. 1992) (emphasis added).

> [sic] re Caveney, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985).
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> The process of patent examination is an interactive one. See generally, Chisum, Patents, § 11.03 et seq. (1992). **The examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection harbored by the examiner.** The 'prima facie case' notion, the exact origin of which appears obscure (see In re Piasecki, 745 F.2d 1468, 1472, 233 USPQ 785, 788 (Fed. Cir. 1984)), seemingly was intended to leave no doubt among examiners that they must state clearly and specifically any objections (the prima facie case) to patentability, and give the applicant fair opportunity to meet those objections with evidence and argument. To that extent the concept serves to level the playing field and reduces the likelihood of administrative arbitrariness.

However, the Examiner failed to establish a prima facie case. See the arguments of record. For example, the Examiner did not properly consider the disclosure as a whole, nor the many occurrences of the claim limitations in the disclosure, nor the relevance of the disclosed actually reduced-to-practice "Experimental System". Further, the Examiner did not establish lack of written description nor the need for any experimentation, much less undue experimentation, in view of the disclosed actually reduced-to-practice "Experimental System". Further, the Examiner did not perform the required Graham[2], Rouffet[3], or Gechter[4] analyses. For these reasons and the other reasons of record, the Examiner did not establish a prima facie case.

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2. Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966).

3. In Re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (emphasis added).

4. Gechter v. Davidson, 116 F.3d 1454, 43 USPQ2d 1030 (Fed. Cir. 1997).

The failure of the Examiner to establish a prima facie case is, by itself, dispositive of all of the rejections. Regarding the art rejections, Judge Hairston in Hyatt-'852[5] stated:

> Without a showing that each and every limitation of the claimed invention is found in the Schutt reference, either explicitly or inherently, the anticipation rejection is reversed....
>
> For all of the reasons set forth in the immediately preceding paragraph, the obviousness rejection based upon the combined teachings of Schutt and Sundet is reversed for lack of a prima facie case of obviousness. Without an initial prima facie case, the burden never shifted to appellant to provide a rebuttal. In re Oetiker 977 F.2d 1443, [] 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)....
>
> As indicated supra, the mere listing of elements does not satisfy the examiner's burden of presenting a prima facie case of obviousness of the claims as a whole.

Similarly, the Examiner herein has failed to establish a prima facie case, which is dispositive of the art rejections.

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5. Ex parte Hyatt, Appeal No. 2001-2172, Paper No. 31 at 8-9 in patent application Serial No. 08/436,852 (PTO Bd. App. July 25, 2002) [herein Hyatt-'852] (unpublished PTO decision) (footnote removed).